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In the Supreme Court of the United States

OCTOBER TERM, 1962

No. ~~893~~ 138

HELEN RUSSELL PIERCE, Executrix of the Last Will and Testament of GEORGE WASHINGTON PIERCE, Deceased,
PETITIONER,

v.

ALLEN B. DUMONT LABORATORIES, INC.,
RESPONDENT.

PETITIONER'S REPLY BRIEF

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The petitioner has asked this Court to decide what the Court of Appeals for the Third Circuit has described (see top of page 9 of the Petition) as "difficult and doubtful points of law".

Three different Courts of Appeals have decided these points of law in four different ways, one of the Courts of Appeals changing its view with respect to those points of law upon a subsequent occasion (p. 6 of petition). Another of those Courts of Appeals has been asked to review its decision (p. 3 of petition) and argument thereon will take place next Tuesday, June 26.[1]

Not only have the three different Courts of Appeals dis-

[1] In its counter statement (certain erroneous parts of which are evident by reference to the actual, *not* respondent's paraphrased or out-of-context extracts from, holdings of the Courts of Appeals), respondent really admits the conflict of the circuits set forth in the petition.

agreed among themselves, but also the District Courts have done the same. One District Court, on two occasions, has arrived at directly contrary results, following one Court of Appeals in the one instance and another Court of Appeals in the second instance (bottom p. 6, top p. 7 of petition).

Not only that, but the decisions of the District Courts have not been approved by their own Courts of Appeals. (p. 5-7 of petition).

The Court of Appeals for the Third Circuit, indeed, in the case here-involved, has, contrary to respondent's erroneous assertion in counter statements #9 and 11, *positively refused* to follow its District Court's holding that the *element* patent is "double patenting" over the *combination* patent, because of the Supreme Court's recent decision in *Aro Mfg. Co.* v. *Convertible Top Replacement Co.*, 1961, 365 U.S. 336 to the effect that a combination claim does *not* protect only an element.

> Were this point essential to our decision it would be necessary to decide whether this view can be squared with recent decisions of the Supreme Court limiting the protection which a patent claiming only a particular combination can give to a constituent element of that combination. (citing the *Aro Mfg. Co.* case, *supra*, and other cases).

Instead, the Court of Appeals for the Third Circuit evolved the *brand new* doctrine of law set forth in the question on page 3 and the quotation on page 7 of the petition; namely, a highly original doctrine of illegal "extension of monopoly":[2]

[2] The so-called illegal extension of monopoly would appear to apply, if at all, whether or not the Patent Office requirement for division (counter statements # 17-19) was "formal" or informal, since the Patent Office obviously could not sanction any *illegal* extension. See footnote 4 of petition.

> We decide merely that patent '496 protected Pierce in the use of the Pierce oscillator in radio transmitting and receiving systems. We have already pointed out that it is the *extension of this monopoly* beyond its proper seventeen year term which invalidates the generic patent. (Emphasis added)

No citations are then given for support of this holding!

While asserting on pages 9 and 10 of its reply, that citations of the Supreme Court and other courts were presented in the decision of the Court of Appeals for the Third Circuit, respondent has failed to call attention to a *single cited decision* as to this doctrine of illegal "extension of monopoly."

Respondent, also on page 10, claims that it knows of no confusion as to the status of combination and element patents; and yet it does *not* refute a single one of the following assertions in the petition that show this:

> Every week the Patent Office is granting hundreds of patents for new combinations of elements as well as for new elements alone, and in no particular order of issuance.
>
> There are in force well over a half a million patents for new combinations of elements, as well as for new elements by themselves, already granted without regard to order of issuance.
>
> The status of all related combination and element patents, previously granted and presently being granted each week *without regard to their order of issuance*, has been thrown into serious doubt.
>
> Who now knows what is and is not an improper extension of a patent?

> Who now knows whether the order in which related combination and element patents issue is or is not of any significance, and thus whether present Patent Office practice is *spawning myriads of invalid patents every week?*

The Supreme Court, it is believed, should resolve this hopeless conflict which the Court of Appeals for the Third Circuit agrees, as before stated, involves

"*difficult* and *doubtful* points of law".

Respectfully submitted,

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